

REMARKS

The Office Action mailed May 30, 2008, has been received and reviewed. Claims 1-4, 6-13 and 15-18 are pending in the present application. Claims 1, 8-10, 17 and 18 have been amended. Applicant respectfully responds to this Office Action and traverses all rejections. No new matter has been added. Reconsideration and further examination are respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

Obviousness Rejection Based on U.S. Patent 6,757,537, U.S. Patent No. 5,872,775 and U.S. Patent No. 6,278,781.

Claims 1, 6, 8-10 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,757,537 to Choi *et al.* ("Choi") in view of U.S. Patent No. 5,872,775 to Saints *et al.* ("Saints") and further in view of U.S. Patent No. 6,278,781 to Rhoads ("Rhoads").

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be "a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicants' disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1, 6, 8-10 and 15 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations.

Regarding independent claim 1 and claim 6 depending therefrom, independent claims 8 and 9, and independent claim 10 and claim 15 depending therefrom, Applicant has amended independent claims 1 and 8-10 to include claim limitations not taught or suggested in the cited references.

Generally, Applicant's invention as presently claimed recites determining and transmitting a prospective traffic-to-pilot ratio in a message. Specifically, Applicant's independent claims 1 and 8-10 each recite, *inter alia*, "determining an energy value for a transmission from a first station to a second station ... forming a message carrying an indicator of the energy value ... wherein the energy value is a traffic-to-pilot ratio". Applicant respectfully asserts that neither Choi nor Saints nor Rhoads, either individually or in any proper combination, teach or suggest Applicant's invention as presently claimed.

The Office Action recites:

Choi discloses ... determining an energy value (i.e., power control parameter has been interpreted as energy value) (see the abstract, column 2, lines 41-52) for transmission from a first station (interpreted as a base station) to a second station (interpreted as a remote terminal) (Office Action, pp. 2, 4; emphasis added).

Regardless of Choi's alleged teaching of determining a power control parameter, Choi does not teach "determining ... a traffic-to-pilot ratio" "for a transmission" as claimed by Applicant.

Generally, Choi teaches or suggests a "power control parameter" used to perform outer loop power control and not "determining ... a traffic-to-pilot ratio" "for a transmission" as claimed by Applicant. (Choi, abstract). The Choi reference specifically teaches or suggests:

- ... a different power control parameter value is assigned according to whether the call occurs between mobile stations or between a mobile station and a wire telephone (Choi, col. 5, lines 52-55).
- ... the base station determines the call type and provides a power control parameter corresponding to the determined call type (Choi, col. 5, lines 60-62).
- ... the mobile station then performs outer loop power control using the power control parameter provided by the base station. (Choi, col. 5, lines 63-65).

Clearly the Choi reference's "power control parameter" is used by the mobile station for performing "outer loop power control," however, the Choi reference does not teach or suggest "determining an energy value for a transmission from a first station to a second station ...

forming a message carrying an indicator of the energy value ... wherein the energy value is a traffic-to-pilot ratio" as claimed by Applicant.

The Office Action concedes, "Choi also does not disclose selecting an index value associated with the energy value, and forming a message carrying the index value. (Office Action, p. 3). The Office Action describes Saints as disclosing "establishment of a link between a mobile unit N and a cell-site N' (i.e. the transmitter), cell site N' transmits an initial ratio of full-rate frame power to pilot power ... to the mobile unit, and this *initial ratio is stored in memory* 44 as the reference ratio. (Office Action, p. 3; emphasis added). Applicant respectfully notes that the "initial ratio" or the "reference ratio" of Saints is determined on the receive side after the traffic and pilot signals are received. Accordingly, neither Choi nor Saints teaches or suggests Applicant's claim elements of "determining an energy value for a transmission from a first station to a second station ... forming a message carrying an indicator of the energy value ... wherein the energy value is a traffic-to-pilot ratio".

The Office Action further cites Rhoads for teaching, "a wireless communication system (see the abstract), wherein a ROM in the telephone device stores 256 different messages. (Office Action, p. 3).

Therefore, since neither Choi nor Saints nor Rhoads teach or suggest Applicant's claimed invention including "determining an energy value for a transmission from a first station to a second station ... forming a message carrying an indicator of the energy value ... wherein the energy value is a traffic-to-pilot ratio", these references, either individually or in any proper combination, cannot render obvious, under 35 U.S.C. §103, Applicant's invention as presently claimed in amended independent claims 1 and 8-10. Accordingly, Applicant respectfully requests the rejection of presently amended independent claims 1 and 8-10 be withdrawn.

The nonobviousness of independent claims 1 and 10 preclude a rejection of claims 6 and 15 which respectively depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to amended independent claims 1 and 10 and claims 6 and 15 which respectively depend therefrom.

Obviousness Rejection Based on U.S. Patent 6,757,537, U.S. Patent No. 5,872,775, U.S. Patent No. 6,278,781 and U.S. Patent No. 6,608,828.

Claims 2 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Choi in view of Saints and Rhoads and further in view of U.S. Patent No. 6,608,828 to Balachandran ("Balachandran").

The nonobviousness of independent claims 1 and 10 preclude a rejection of claims 2 and 11 which respectively depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to amended independent claims 1 and 10 and claims 2 and 11 which respectively depend therefrom.

Obviousness Rejection Based on U.S. Patent 6,757,537, U.S. Patent No. 5,872,775, U.S. Patent No. 6,278,781 and U.S. Patent No. 6,389,034.

Claims 3, 4, 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Choi in view of Saints and Rhoads and further in view of U.S. Patent No. 6,389,034 to Guo *et al.* ("Guo").

The nonobviousness of independent claims 1 and 10 preclude a rejection of claims 3, 4, 12 and 13 which respectively depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to amended independent claims 1 and 10 and claims 3, 4, 12 and 13 which respectively depend therefrom.

Obviousness Rejection Based on U.S. Patent 6,757,537, U.S. Patent No. 5,872,775, U.S. Patent No. 6,278,781 and U.S. Patent No. 6,643,272.

Claims 7 and 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Choi in view of Saints and Rhoads and further in view of U.S. Patent No. 6,643,272 to Moon ("Moon").

Regarding claims 7 and 16, the nonobviousness of independent claims 1 and 10 preclude a rejection of claims 7 and 16 which respectively depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to amended independent claims 1 and 10 and claims 7 and 16 which respectively depend therefrom.

Regarding claims 17 and 18, to establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); see also MPEP § 2143.03. Additionally, there must be “a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicants’ disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 17 and 18 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations.

Regarding independent claims 17 and 18, Applicant has amended independent claims 17 and 18 to include claim limitations not taught or suggested in the cited references. Generally, Applicant’s invention as presently claimed recites determining and transmitting a prospective traffic-to-pilot ratio in a message. Specifically, Applicant’s independent claims 17 and 18 each recite, *inter alia*, “determining an energy value for a transmission [.] to a second/base station ... forming a message carrying an indicator of the energy value ... wherein the energy value is a traffic-to-pilot ratio”. Applicant respectfully asserts that neither Choi nor Saints nor Rhoads nor

Moon, either individually or in any proper combination, teach or suggest Applicant's invention as presently claimed.

The Office Action recites:

Choi discloses ... determining an energy value (i.e., *power control parameter has been interpreted as energy value*) (see the abstract, column 2, lines 41-52) for transmission from a first station (interpreted as a base station) to a second station (interpreted as a remote terminal) (Office Action, pp. 8, 10; emphasis added).

Regardless of Choi's alleged teaching of determining a power control parameter, Choi does not teach "determining ... a traffic-to-pilot ratio" "for a transmission" as claimed by Applicant.

Accordingly, Applicant herein sustains the above-proffered arguments relating to the lack of teaching or suggestion in Choi, Saints and Rhoads. The Office Action cites Moon for teaching a system in which the other elements may be practiced. (Office Action, pp. 9, 11).

Therefore, since neither Choi nor Saints nor Rhoads nor Moon teach or suggest Applicant's claimed invention including "determining an energy value for a transmission [] to a second/base station ... forming a message carrying an indicator of the energy value ... wherein the energy value is a traffic-to-pilot ratio", these references, either individually or in any proper combination, **cannot** render obvious, under 35 U.S.C. §103, Applicant's invention as presently claimed in amended independent claims 17 and 18. Accordingly, Applicant respectfully requests the rejection of presently amended independent claims 17 and 18 be withdrawn.

CONCLUSION

Claims 1-4, 6-13 and 15-18 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicant's undersigned attorney.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

Dated September 30, 2008

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